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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,358	03/21/2007	Jonni Ahlgren	0696-0224PUS1	1709
2292 7590 10/29/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
MINSKEY, JACOB T				
ART UNIT		PAPER NUMBER		
1791				
NOTIFICATION DATE		DELIVERY MODE		
10/29/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/553,358	Applicant(s) AHLGREN ET AL.
Examiner JACOB T. MINSKEY	Art Unit 1791

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 October 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 10/16/2009. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: 13 and 29
Claim(s) rejected: 2-31, 35 and 36
Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Eric Hug/
Primary Examiner, Art Unit 1791

Continuation of 3. NOTE: The proposed amendments would overcome the previously presented claim objections to claims 13 and 29 if entered, as well as overcome the 112 2nd rejections presented in the Final Rejection if entered. The Examiner acknowledges the addition of claims 37-49. The amended claims and newly added claims do not present new matter, but they do raise new issues by presenting additional combinations of limitations that have not been previously addressed. Additionally, 13 new claims have been added without canceling a corresponding number of finally rejected claims.

Continuation of 11, does NOT place the application in condition for allowance because:

1. The Applicant traverses the obviousness rejection presented in the Final Office Action. Applicant argues that the Greenwood reference is irrelevant to the present invention. The Examiner respectfully disagrees. Greenwood is utilized to teach the treating of the formed stock with a cationic retention agent with a weight of at least 500,000 g/mol in a papermaking system. The fact that Greenwood does not teach all of the claimed limitations is irrelevant because it is utilized as a secondary reference in a 103 obviousness rejection. It is the combination of the Freeman and Greenwood references that is used to reject the claims, not one or the other. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

2. Applicant also argues that the Freeman '617 (which the Examiner is assuming is referring to Freeman and not Greenwood) teaches different steps and additional process steps of spray drying to modify the clay in a desired manner. The Examiner states that the independent claim is open ended by the presence of the transitional phrase "comprising." The claim only states that the filler must be pretreated with the inorganic colloid of an average particle size. The claim does not state how the pre-treating must take effect. It is the Examiner's stance that the mixing and spray drying process reads on the act of "pre-treating a filler with inorganic colloid particles." It is also the Examiner's stance that the size of the inorganic colloid particle is presented at the start of the pre-treatment process and not the end. It does not matter that the filler has a larger BET surface area after the treatment as argued, because there is nothing in the claim language that states how big the filler and particles are after pre-treatment.

3. On page 13 of the Response, Applicant states that "In the present invention, the treatment of filler with colloidal material is a one step process that cannot be carried out beforehand as in Freeman." The Examiner respectfully disagrees. Independent claim 35 states to pre-treat a filler, then to suspend the pretreated filler to make an aqueous slurry, then to combine with a pulp to make a stock, and then to treat the stock. The claim expressly requires that the filler is pretreated prior to any other operation. Freeman teaches in col 2 lines 45-53 that the pretreated filler of Freeman is used by forming a slurry and being incorporated up to 50% as a filler in producing papers.

4. Applicant also argues that Freeman does not "promote the runability of a paper production process." Freeman teaches in col 4 line 61- col 5 line 10 that the pretreated filler created by the Freeman method can be utilized in high solid slurries to increase the Hercules viscosity of the final product, and that the high viscosity correlates to slurry pumpability and paper coating runnability. The teachings of Freeman would lead on of ordinary skill in the art to understand that the high solid slurries to be created for the paper application would increase the retention of the final product due to the high viscosities and high solids. Additionally this is why the Greenwood reference was utilized (see discussion above), to have an express teaching of the additional of a cationic retention agent to increase the retention of the paper.

5. The remaining arguments are focused on additional dependent claims and are based on the same arguments as presented above.